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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,589	07/22/2004	Tadashi NAKATANI	040348	4588
23850 7590 09/28/2007 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. Suite 400 WASHINGTON, DC 20005			EXAMINER ROJAS, BERNARD	
			ART UNIT 2832	PAPER NUMBER
			MAIL DATE 09/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/710,589

Applicant(s)

NAKATANI ET AL.

Examiner

Bernard Rojas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 3, 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 07/12/2007 have been fully considered but they are not persuasive.

Applicant states that the issue is whether it is appropriate to apply the teaching of Yao (teaching that a driving electrode can be formed on the surface of a cantilever arm that is opposite the base substrate) to Aigner [page 1 of the Remarks].

In response, as previously outlined, Aigner et al. discloses the claimed invention with a difference in how the first driving electrode is made. The driving electrode of Aigner et al. is made by doping a portion of the cantilever arm that is, in part, located on the surface of the cantilever arm that is opposite the substrate. Yao is being used to teach that a driving electrode can be formed separate from the cantilever arm, on the surface of a cantilever arm that is opposite the base substrate.

The combination of forming a driving electrode separate from the cantilever arm and located on the surface of a cantilever arm that is opposite the base substrate, as shown by Yao, and the contact structure disclosed by Aigner yields the claimed driving electrode/contact structure since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

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hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aigner et al. [US 6,734,770] in view of Yao [US 5,578,976].

Claim 1, Aigner et al. discloses a micro-switching device comprising a base substrate [1]; a movable portion [9] including an anchor part [4] and an extending part, the anchor part being connected to the base substrate, the extending part extending from the anchor part and facing the base substrate, wherein the extending part comprises a body having an electrode carrying surface [21,22] on a side opposite to the base substrate; a movable contact conductor [71, 72] provided on the electrode carrying surface of the extending part; a first stationary contact electrode [31a, 32a] fixed to the base substrate and including a first contacting part facing the movable contact conductor; and a second stationary contact electrode [31b, 32b] fixed to the base substrate and including a second contacting part facing the movable contact conductor [figures 1 and 2]; and a first driving electrode [6] on the movable portion.

Aigner fails to teach that the first driving electrode is formed on the electrode carrying surface of the extending part separately from the body of the movable portion.

Yao discloses a MEM switch with a first driving electrode [24] formed separately from the body [20] of the movable portion of the cantilever, located on the surface of the cantilever arm that is opposite the substrate [12].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the first driving electrode of Aigner separately from the body of the movable portion and located on the cantilever arm surface that is opposite the base substrate as shown by Yao, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claim 2, Aigner et al., as modified, discloses the micro-switching device according to claim 1, further comprising a second driving electrode [51, 52] fixed to the base substrate and including a section facing the first driving electrode said section of the second driving electrode being spaced from the base substrate on a same side as the first driving electrode relative to the base substrate.

Claim 4, Aigner et al. discloses the micro-switching device according to claim 1, wherein the extending part is made of monocrystalline silicon [col. 3 line 62 to col. 4 line 10].

Claim 7, Aigner et al. discloses a micro-switching device comprising a base substrate [1]; a movable portion [9] including an anchor part [4] and an extending part, the anchor part being connected to the base substrate, the part extending from the extending anchor part and facing the base substrate; wherein the extending part comprises a body having an electrode carrying surface [21,22] on a side opposite to the base substrate; a stationary member [2, 11] connected to the base substrate; a movable contact conductor [71, 72] provided on the electrode carrying surface of the extending part; a first stationary contact electrode [31a, 32a] connected to the stationary member and including a first contacting part facing the movable contact conductor; a second stationary contact electrode [31b, 32b] connected to the stationary member and including a second contacting part facing the movable contact conductor [figures 1 and 2]; and a first driving electrode [6] on the movable portion.

Aigner fails to teach that the first driving electrode is formed on the electrode carrying surface of the extending part separately from the body of the movable portion.

Yao discloses a MEM switch with a first driving electrode [24] formed separately from the body [20] of the movable portion of the cantilever, located on the surface of the cantilever arm that is opposite the substrate [12].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the first driving electrode of Aigner separately from the body of the movable portion and located on the cantilever arm surface that is opposite the base substrate as shown by Yao, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claim 8, Aigner et al. discloses the micro-switching device according to claim 7, wherein the stationary member is spaced away from the movable portion [figures 1 and 2].

Claim 9, Aigner et al. discloses the micro-switching device according to claim 7, wherein the stationary member surrounds the movable portion [figure 1].

Claim 10, Aigner et al. discloses the micro-switching device according to claim 7, wherein the stationary member includes a plurality of stationary island parts that are spaced away from one another and are each connected to the base substrate [figure 1].

Claim 11, Aigner et al. discloses the micro-switching device according to claim 7, further comprising a second driving electrode [53, 54] connected to the stationary member and including a section facing the first driving electrode [figure 3].

Claim 12, Aigner et al. discloses the micro-switching device according to claim 7, wherein the extending part is made of monocrystalline silicon [col. 3 line 62 to col. 4 line 10].

Claims 5 and 13, Aigner et al. discloses the claimed invention except for the thickness of the contact electrode. It would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the thickness of the contact electrode to minimize signal distortion depending on the voltage and/or frequency of the signal. Since applicant has not disclosed that a contact electrode thickness of at least 5 micrometer solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well as taught by Aigner et al.

Claims 6 and 14, Aigner et al. discloses the claimed invention except for the thickness of the extending part. It would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the thickness of the extending part in order to change the spring characteristic/response time/opening force [i.e. thick = slower response time and greater opening force, smaller equals faster actuation time and small opening force] of the moveable part. Since applicant has not disclosed that a extending part thickness of at least 5 micrometer solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well as taught by Aigner et al.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Rojas whose telephone number is (571) 272-1998. The examiner can normally be reached on M and W-F, 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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